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EXAMINER

DESIR, PIERRE LOUIS

ART UNIT	PAPER NUMBER
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2681

DATE MAILED: 12/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/697,161

Applicant(s)

CHEN ET AL

Examiner

Pierre-Louis Desir

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 October 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Objections

1. Claims 18-19 are objected to because of the following informalities: "A method" should be "a telecommunications system." Appropriate correction is required.

For purpose of examination as related to claim 18 and 19, a method will be treated as a telecommunications system.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-3, 5-11 are rejected under 35 U.S.C. 102(e) as being anticipated by Jiang et al. (Jiang), Pub. No. US2004/0120494.

Regarding claim 1, Jiang discloses a telephone communications system comprising a plurality of mobile telephone stations (i.e. calling party 108, and called party 110) (see fig. 1, page 2, paragraph 21), a plurality of base stations interfaced for wireless communications with the plurality of mobile stations (as known in the art, base stations are typically used two-way radios such as mobile phone and portable phones. When one talks on such a mobile phone, one is talking to a nearby base station. From that base station the phone call is connected into the regular land-line phone system by the mobile phone network; thus the disclosure of the plurality

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of base stations is inherent), and a mobile switching center connected in a mobile telephone network to the base stations for controlling wireless telephone communications (see fig. 1, page 2, paragraph 21), a method for processing an incoming call from a caller for a mobile telephone station subscriber in response to receipt of the incoming call at a home or gateway mobile switching center for the subscriber (see page 2, paragraph 21), the method comprising the steps of: determining whether the called mobile station subscriber subscribes to an alternative ringback feature (i.e. the MSC contacts the HLR, which performs a database look-up for user and returns a service flag which provides information including whether the user has subscribed to a ringtone feature) (see fig. 2, page 3, paragraph 30); establishing a call path to the caller between the subscriber mobile switching center and an audio content server (inherent) if the mobile station subscriber subscribes to the alternative ringback feature (i.e. the IP receives the message from MSC and generates the custom ringtone. This ringtone will be transmitted from EP to MSC from where it can be routed back to caller) (see fig. 2, page 3, paragraph 34); transmitting a pre-selected audio presentation from the audio content server to the caller in lieu of audible ringback signals (see page 1, paragraph 7, page 2, paragraph 26); identifying the call location of the called subscriber station (i.e. to initiate the process, the user at one mobile station dials the telephone number for a subscriber. Accordingly, a message is sent to MSC, which is MSC local to the user's location, which will route the call to the called subscriber MSC) (see page 3, paragraph 29); extending a call leg from the subscriber mobile switching center to the subscriber station or a subscriber call forwarding station (i.e. transmission from EP to MSC from where ringtone can be routed back to caller) (see fig. 2, page 3, paragraph 34); in response to an answer of the call by the subscriber station or a subscriber call forwarding station, disconnecting the audio content

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server from the caller and connecting the caller to the call leg (i.e. When the connection with called party is complete, the custom ringtone would typically be disconnected. The network would then connect parties so that the communication could commence. Also, it should be noted that the audio clips are stored in an inherent audio/sound server) (see fig. 2, page 3, paragraph 36).

Regarding claim 2, Jiang discloses a method as described in claim 1 rejection, wherein the step of determining whether the called mobile station subscriber subscribes to an alternative ringback feature comprises querying a home location register (i.e. the MSC contacts home location register, which performs a database look-up for user and returns a service flag to the MSC) (see page 3, paragraph 30).

Regarding claim 3, Jiang discloses a method as described in claim 1 rejection, wherein the step of identifying comprises querying a home location register (i.e. the MSC is coupled to the home location register. When the call process is initiated, a message is sent to MSC, which is MSC local to the user's location, which routes the call to MSC of the called subscriber. As known in the art the MSC local to the user's location contacts the home location register for database look-up) see page 2, paragraph 22, and page 3, paragraph 29-30).

Regarding claim 5, Jiang discloses a method as described in claim 3 rejection, wherein the step of establishing a call path to the audio content server comprises determining the network address of the audio content server from information contained in the home location register (the subscriber could have access to a storage unit (not shown) where the subscriber stores a custom ringtone. For example, the storage unit could be accessible via the Internet. The message from MSC would provide an address to IP indicating where this unique clip is

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stored. IP could then access the unique ringtone and provide it to MSC) (see fig. 2, page 3, paragraph 35).

Regarding claim 6, Jiang discloses a method as described in claim 1 rejection, wherein the step of transmitting a pre-selected audio presentation comprises accessing one of a plurality of stored audio presentations on the basis of subscriber identified criteria (see fig. 2, page 3, paragraph 33).

Regarding 7, Jiang discloses a method as described in claim 6, wherein the subscriber identified criteria is related to the identity of the caller (i.e. as disclosed earlier the MSC contacts HLR, which performs a database look-up for user and returns a service flag to the MSC. The service flag provides a number of pieces of. As known in the art the HLR is the element where all of the subscribers' data is stored. It contains a database of all an operator's subscribers keyed. Data stored includes: the subscriber's identity number, the subscriber's phone number, and current location of subscriber) (see page 3, paragraph 30).

Regarding claim 8, Jiang discloses a method as described in claim 6 rejection, wherein the subscriber identified criteria is related to the geographical location of the caller (i.e. as disclosed earlier the MSC contacts HLR, which performs a database look-up for user and returns a service flag to the MSC. The service flag provides a number of pieces of. As known in the art the HLR is the element where all of the subscribers' data is stored. It contains a database of all an operator's subscribers keyed. Data stored includes: the subscriber's identity number, the subscriber's phone number, and current location/geographical location of subscriber) (see page 3, paragraph 30).

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Regarding claim 9, Jiang discloses a method as described in claim 6 rejection, wherein the subscriber identified criteria is related to the time of day of the incoming call to the subscriber mobile switching center (i.e. the ringtones can be unique to the particular subscriber and may be based upon time of day, day of week, time of year, calling party number, or other factors) (see page 3, paragraph 35).

Regarding claim 10, Jiang discloses a method as described in claim 6 rejection, wherein the transmitted audio presentation is a musical selection (i.e. the ringback tones will typically be clips of musical composition, announcements, audio clips, video clips, etc. that the service control point instructs the switch and an intelligent peripheral to play back to the calling party in place of standard ringing (see page 1, paragraph 7).

Regarding claim 11, Jiang discloses a method as described in claim 6 rejection, wherein the transmitted audio presentation is a prerecorded message (For example, the subscriber could have access to a storage unit (not shown) where the subscriber stores a custom ringtone (e.g., a 60 second advertisement clip or an individually recorded greeting). For example, the storage unit could be accessible via the Internet. The message from MSC would provide an address to IP indicating where this unique clip is stored. IP could then access the unique ringtone and provide it to MSC) (see page 3, paragraph 35).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jiang in view of Nguyen, U.S. Patent No. 5699407.

Jiang discloses a method as described in claim 3 rejection above (see claim 3 rejection).

Although, Jiang described a method as stated in the rejection of claim 3, Jiang fails to specifically disclose a method, wherein the subscriber station is in a roaming location and the step of identifying further comprises establishing a temporary routing number for the subscriber station.

However, Nguyen discloses a method wherein the subscriber station is in a roaming location and the step of identifying further comprises establishing a temporary routing number for the subscriber station (a HLR consults its database to determine the current physical location of the mobile station assigned to the directory number being called, and identifies a particular visited exchange or visited location register within the system as the current location of the called mobile station. A routing request is sent to the visited location register or visited exchange, which sends a routing request return result to the HLR, such message including a temporary routing number. The HLR forwards the temporary routing number in a location request return result message to the interrogation exchange) (see col. 4, lines 48-62).

Jiang and Nguyen are analogous art because they are from the same field of endeavor.

Therefore, it would have obvious to one of ordinary skill in the art at the time of the invention to combine the method of Jiang with the method of Nguyen to arrive at the claimed invention. A motivation to do so would have been to provide an efficient method of implementing mobile extension phone service (see col. 2, lines 11-13).

6. Claims 12-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jiang in view of No et al (No), Pub. No. US 2004/0132435.

Regarding claim 12, Jiang discloses a mobile telephone communication system comprising a plurality of base stations interfaced for wireless communications with a plurality of mobile stations (i.e. calling party 108, and called party 110. Also, as known in the art, base stations are typically used two-way radios such as mobile phone and portable phones. When one talks on such a mobile phone, one is talking to a nearby base station. From that base station the phone call is connected into the regular land-line phone system by the mobile phone network; thus the disclosure of the plurality of base stations is inherent) (see fig. 1, page 2, paragraph 21; a mobile switching center connected in a mobile telephone network to the base stations for controlling wireless telephone communications (see fig. 1, page 2, paragraph 21); a home location register coupled to the mobile telephone network and having stored therein identification of mobile stations subscribed to the alternative ringback feature (i.e. as disclosed earlier the MSC contacts HLR, which performs a database look-up for user and returns a service flag to the MSC. The service flag provides a number of pieces of. As known in the art the HLR is the element where all of the subscribers' data is stored. It contains a database of all an operator's subscribers keyed . Data stored includes: the subscriber's identity number, the subscriber's phone number, and current location of subscriber) (see page 3, paragraph 30); wherein in response to receipt of an incoming call at the mobile switching center, determination is made whether the called mobile station subscriber subscribes to an alternative ringback feature by a query to the home location register (i.e. the MSC contacts the HLR, which performs a

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database look-up for user and returns a service flag which provides information including whether the user has subscribed to a ringtone feature) (see fig. 2, page 3, paragraph 30), a call path is established to the caller between the subscriber mobile switching center and an audio content server if the mobile station subscriber subscribes to the alternative ringback feature (i.e. the IP receives the message from MSC and generates the custom ringtone. This ringtone will be transmitted from EP to MSC from where it can be routed back to caller) (see fig. 2, page 3, paragraph 34); a pre-selected audio presentation is transmitted from the audio content server to the caller in lieu of audible ringback signals (see page 1, paragraph 7, page 2, paragraph 26); the call location of the called subscriber station is identified (i.e. along with the contact of the HLR, to initiate the process, the user at one mobile station dials the telephone number for a subscriber. Accordingly, a message is sent to MSC, which is MSC local to the user's location, which will route the call to the called subscriber MSC) (see page 3, paragraphs 29-30); a call leg is extended from the subscriber mobile switching center to the subscriber station or a subscriber call forwarding station (i.e. transmission from EP to MSC from where ringtone can be routed back to caller) (see fig. 2, page 3, paragraph 34); and in response to an answer of the call by the subscriber station or a subscriber call forwarding station, the audio content server is disconnected from the caller and the caller is connected to the call leg (i.e. When the connection with called party is complete, the custom ringtone would typically be disconnected. The network would then connect parties so that the communication could commence. Also, it should be noted that the audio clips are stored in an inherent audio/sound server) (see fig. 2, page 3, paragraph 36).

Although Jiang discloses a mobile communications system as disclosed above, though inherent the disclosure of audio content server may be, Jiang fails to specifically disclose and an audio content server coupled to the mobile telephone network.

However, No discloses an audio content server (i.e. sound storage server) coupled to the mobile telephone network (see fig. 1, page 1, paragraph 18).

Jiang and No are analogous art because they are from the same field of endeavor.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine both teachings to arrive at the claimed invention. A motivation to do so is to allow the sound server to search its database for a sound specified by the caller, and provides the found sound for the caller instead of a conventional ringback tone (see abstract).

Regarding claim 13, Jiang discloses a telecommunications system as described in claim 12 rejection.

Although Jiang discloses a telecommunications system in which a plurality of stored audio presentations available for selection by subscribers to the alternative ringback feature to be transmitted during an incoming call and storage means for associating subscribers with selected audio presentations (see fig. 2, page 3, paragraph 33), Jiang fails to specifically disclose an audio content server coupled to the network.

However, No discloses an audio content server (i.e. sound storage server) coupled to the mobile telephone network (see fig. 1, page 1, paragraph 18).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine both teachings to arrive at the claimed invention. A motivation to do so is

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to allow the sound server to search its database for a sound specified by the caller, and provides the found sound for the caller instead of a conventional ringback tone (see abstract).

Regarding claim 14, a telecommunications system as described in claim 12 rejection, wherein the storage means contains subscriber identified criteria associating a plurality of stored presentations with a subscriber to the alternative ringback feature (see fig. 2, page 3, paragraph 33).

Although Jiang discloses a telecommunications system as described, because of the dependency of this claim on claim 12, Jiang fails to specifically disclose and an audio content server coupled to the mobile telephone network.

However, No discloses an audio content server (i.e. sound storager server) coupled to the mobile telephone network (see fig. 1, page 1, paragraph 18, page 2, paragraph 21).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine both teachings to arrive at the claimed invention. A motivation to do so is to allow the sound server to search its database for a sound specified by the caller, and provides the found sound for the caller instead of a conventional ringback tone (see abstract).

Regarding claim 15, Jiang discloses a telecommunications system as described (see claim 14 rejection), wherein the subscriber identified criteria is related to the identity of the caller (i.e. as disclosed earlier the MSC contacts HLR, which performs a database look-up for user and returns a service flag to the MSC. The service flag provides a number of pieces of. As known in the art the HLR is the element where all of the subscribers' data is stored. It contains a database of all an operator's subscribers keyed . Data stored includes:the subscriber's identity number, the subscriber's phone number, and current location of subscriber) (see page 3, paragraph 30).

Although Jiang discloses a telecommunications system as described, because of the dependency of this claim on claim 14, Jiang fails to specifically disclose and an audio content server coupled to the mobile telephone network.

However, No discloses an audio content server (i.e. sound storager server) coupled to the mobile telephone network (see fig. 1, page 1, paragraph 18, page 2, paragraph 21).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine both teachings to arrive at the claimed invention. A motivation to do so is to allow the sound server to search its database for a sound specified by the caller, and provides the found sound for the caller instead of a conventional ringback tone (see abstract).

Regarding claim 16, Jiang discloses a telecommunications system as described in claim 14 rejection, wherein the subscriber identified criteria is related to the geographical location of the caller (i.e. as disclosed earlier the MSC contacts HLR, which performs a database look-up for user and returns a service flag to the MSC. The service flag provides a number of pieces of. As known in the art the HLR is the element where all of the subscribers' data is stored. It contains a database of all an operator's subscribers keyed . Data stored includes:the subscriber's identity number, the subscriber's phone number, and current location/geographical location of subscriber) (see page 3, paragraph 30).

Although Jiang discloses a telecommunications system as described, because of the dependency of this claim on claim 14, Jiang fails to specifically disclose and an audio content server coupled to the mobile telephone network.

However, No discloses an audio content server (i.e. sound storager server) coupled to the mobile telephone network (see fig. 1, page 1, paragraph 18, page 2, paragraph 21).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine both teachings to arrive at the claimed invention. A motivation to do so is to allow the sound server to search its database for a sound specified by the caller, and provides the found sound for the caller instead of a conventional ringback tone (see abstract).

Regarding claim 17, Jiang discloses a telecommunications system as described in claim 14 rejection, wherein the subscriber identified criteria is related to the time of day of the incoming call to the subscriber mobile switching center (i.e. the ringtones can be unique to the particular subscriber and may be based upon time of day, day of week, time of year, calling party number, or other factors) (see page 3, paragraph 35).

Although Jiang discloses a telecommunications system as described, because of the dependency of this claim on claim 14, Jiang fails to specifically disclose and an audio content server coupled to the mobile telephone network.

However, No discloses an audio content server (i.e. sound storager server) coupled to the mobile telephone network (see fig. 1, page 1, paragraph 18, page 2, paragraph 21).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine both teachings to arrive at the claimed invention. A motivation to do so is to allow the sound server to search its database for a sound specified by the caller, and provides the found sound for the caller instead of a conventional ringback tone (see abstract).

Regarding claim 18, Jiang discloses a telecommunications system (see claim 12 rejection), wherein the transmitted audio presentation is a musical selection selection (i.e. the ringback tones will typically be clips of musical composition, announcements, audio clips, video

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clips, etc. that the service control point instructs the switch and an intelligent peripheral to play back to the calling party in place of standard ringing (see page 1, paragraph 7).

Although Jiang discloses a telecommunications system as described, because of the dependency of this claim on claim 12, Jiang fails to specifically disclose and an audio content server coupled to the mobile telephone network.

However, No discloses an audio content server (i.e. sound storager server) coupled to the mobile telephone network (see fig. 1, page 1, paragraph 18, page 2, paragraph 21).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine both teachings to arrive at the claimed invention. A motivation to do so is to allow the sound server to search its database for a sound specified by the caller, and provides the found sound for the caller instead of a conventional ringback tone (see abstract).

Regarding claim 19, Jiang discloses a telecommunications system (see claim 12 rejection), wherein the transmitted audio presentation is a prerecorded message (For example, the subscriber could have access to a storage unit (not shown) where the subscriber stores a custom ringtone (e.g., a 60 second advertisement clip or an individually recorded greeting). For example, the storage unit could be accessible via the Internet. The message from MSC would provide an address to IP indicating where this unique clip is stored. IP could then access the unique ringtone and provide it to MSC) (see page 3, paragraph 35).

Although Jiang discloses a telecommunications system as described, because of the dependency of this claim on claim 12, Jiang fails to specifically disclose and an audio content server coupled to the mobile telephone network

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However, No discloses an audio content server (i.e. sound storager server) coupled to the mobile telephone network (see fig. 1, page 1, paragraph 18, page 2, paragraph 21).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine both teachings to arrive at the claimed invention. A motivation to do so is to allow the sound server to search its database for a sound specified by the caller, and provides the found sound for the caller instead of a conventional ringback tone (see abstract).

conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Takeushi, Pub. No. US 2002/0183048, " Portable Terminal Service Method."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pierre-Louis Desir whose telephone number is 703-605-4312. The examiner can normally be reached on Monday-Friday from 0800-1630.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David R Hudspeth can be reached on (703) 308-4825. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Pierre-Louis Desir
AU 2681
12/04/2004

JEAN GELIN
PRIMARY EXAMINER

